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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,965	12/07/2001	Paul J. Datta	KCC-16,986	5676

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/27/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

<b>Office Action Summary</b>	Application No. 10/010,965	Applicant(s) DATTA ET AL.	
	Examiner Karin M. Reichle	Art Unit 3761	

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 13-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
    If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
    1. ☐ Certified copies of the priority documents have been received.  
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
    \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
    a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓ / / /                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,7,8,11</u> . | 6) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group I, claims 1-12, in Paper No. 10 is acknowledged.
2. Claims 13-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 10.
3. The restriction requirement in Paper No. 9 is deemed proper and made FINAL.

### ***Drawings***

4. The drawings are objected to because in Figure 1, the lines from 54, 56 and 58 should be dashed to denote underlying structure. This also applies to the lines from 54 and 56 in Figure 2, the lines from 54, 56 and 58, in Figures 3 and 5, and the lines from 58, 63 and 65 in Figure 4. Also Figures 4 and 17-27 are inconsistent with the description thereof on page 12, first and last full paragraphs, i.e. Figures are partly cutaway and are photographs. In Figure 5, where is 66? A proposed drawing correction or corrected drawings are required in reply to the Office action to

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avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Specification*

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

6. The use of the trademark KRATON(R)(page 42) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capitals or with a symbol but not both.

7. The disclosure is objected to because of the following informalities: 1) The description of Figure 4 on page 12 is inconsistent with the Figure 4, see discussion supra. 2) Are Triton(page 24) and Chisso(page 25) trademarks? If so they should be properly shown as such. 3) On page 30, line 9, should "back" be --front--? 4) With respect to Figure 4, are the two elements shown as 66 on the inside of the front panel in addition to or used in the alternative to 66 on the outside surface of the front panel as shown in Figures 1-3? See also the paragraph bridging pages 32-33

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for example. 5) The description of what is a “passive bond” or “passively bonded” and how it is achieved is unclear due to the inconsistent description throughout the specification and claims. For example, in the Summary of the Invention section, page 5, first paragraph and page 7, first two full paragraphs, passive bonds are described as causing minimal tearing to the back ear or allows the front ear to tear more easily. Yet on page 10, lines 3-7, a passive bond is defined as not tearing or severely damaging portions other than the bond. Furthermore, in the paragraph bridging pages 42-43, it is described that the ear 107 which includes a second material has a higher basis weight than the first ear 106 including a first material. On page 51, lines 5-8 it is disclosed that the basis weight for each ear should also be greater than about 30 gsm to prevent tearing. Yet in the claims a first material which forms the first ear and a second material which forms the second ear are different and passively bonded and have basis weights alone that can be less than 30 gsm and can be the same. Therefore, a clear, complete, consistent description of what a passive bond is should be set forth throughout the specification, e.g. does the bond permit tearing or not? If so, how much and where? What permits the passive bonding? The combined material or material of the ears or just a material of the ears? What is the basis weight required? Is the tensile strength that of the second ear or the second material? Regardless of the specific basis weight is there a relationship between the basis weights that must exist, i.e. one larger and one smaller?

Appropriate correction is required.

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***Claim Objections***

8. Claims 9-12 are objected to because of the following informalities: in the preamble of claims 9-12, "prefastened" should be deleted to be consistent with the other preambles.

Appropriate correction is required.

***Prior Art Rejections***

9. Due to the lack of clarity discussed above, for the purposes of examination on the merits of claims 1-7, the claimed invention will be interpreted as any manually tearable bond between two different materials of ear panels for claim 1, the materials having different basis weights for claims 2-6 and one of the materials having a tensile strength such that it does not tear when the bond tears for claim 7.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al '589

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See Figures 3-3A, then see Figures 5-7, then see Figure 4. Also see Figures 1-2, col. 3, lines 56-60, col. 6, line 16-col. 7, line 12, col. 7, line 38-col. 8, line 44 and col. 9, lines 6-42, i.e. the front waist region is 56, the back waist region is 54, the crotch region is 57, the first ear panel is 202, the second ear panel is 200 and the bond is 205, 300, see again Figures 4 and 5, i.e. a tearable 205 could also be used as 205 in Figure 4, and 200 and 202 are different materials of different basis weights, see again, for example the paragraph bridging cols. 7-8, and the panels have tensile strength such that the bond will tear before the panels do, see again col. 9, lines 28-30. Also note col. 9, lines 20-24.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al in view of McNichols, '805, and thus also Morman '992.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

In claims 9-11 Applicant claims specific materials of the first and second ear panel. It is noted that the claims do not limit the panels or materials thereof only to the specified materials, or



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in other words the ears and materials can include additional elements. In claims 11-12 Applicant claims specific peel strengths. The Johnson et al reference does not explicitly teach such. It is noted however that Johnson et al do teach readily tearable side bonds and that the ear panels can be any material known in the art that is suitable for use in disposable articles which may be joined together by a seam. However see McNichols at col. 16, lines 6-24 and col. 13, lines 15-30, and thereby Morman at Figure 5, Example 3, col. 6, lines 47-54, col. 8, lines 30-40, i.e. a material known in the art suitable for use in disposable articles includes point bonded nonwoven materials as claimed in claim 9 and laminates as claimed in claim 10 and readily tearable bonds of such material have peel strengths as set forth in claims 11 and 12. To employ the materials and peel strengths as taught by McNichols on the Johnson et al device would be obvious to one of ordinary skill in the art in view of the recognition that such materials are known materials in the art suitable for use in disposable articles and that such peel strengths between such materials provide readily tearable bonds and the desire by Johnson to employ any material known in the art that is suitable for use in disposable articles and to provide bonds with such material that are readily tearable. Applicant's attention is also invited to the discussion of prior art *infra*.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Buell et al '827, paragraphs bridging cols. 18-19 and PCT '780, page 15, first full paragraph. Note also Glaug '417, col. 6, lines 23-32. Attention is also directed to *In re Allen et*

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al, 105 USPQ 233(Where the general conditions of a claim are disclosed in the prior art , it is not inventive to discover the optimum or workable ranges by routine experimentation). Even if McNichols were disqualified as a reference, the art appears to recognize the general conditions of controlling the strength of the bond, i.e the peel strength, by the properties of the materials involved, including basis weights and tensile strengths, and the desire to do such between panels in a disposable article.

15. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday.

The Official RightFAX number is 703-872-9302.

*K.M. Reichle*  
**K.M. Reichle**  
**EXAMINER**

KMR

June 18, 2003